

REMARKS

In response to the Non-Final Office Action mailed August 5, 2009, ("Office Action")¹, the response for which is due November 5, 2009, Applicant respectfully requests reconsideration.

I. Interview Summary

Applicant thanks Examiner Parker for the courtesies shown during a telephonic interview conducted on November 4, 2009. In attendance was Examiner Parker and counsel for Applicant, Charulata J. Shah (Reg. No. 47,681) of Accenture and Maura K. Moran (Reg. No. 31,859) of Finnegan. No agreement was reached during the interview, but the Examiner agreed to consider Applicant's arguments to resolve the rejections presented in the Office Action. The substance of the interview is made of record in the remarks below.

II. Status and Disposition of the Claims

In the instant application, claims 1-6, 8-14, and 27-30, of which claims 1, 9, 27, and 29 are independent, are pending and under consideration on the merits.

In the Office Action the following actions were taken:

- Claims 1-6, 8-14, and 27-28 were rejected under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory matter. See Office Action at pages 2-3.
- Claims 1-6, 8-14, and 27-30 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. See Office Action at pages 3-4.
- Claims 1-6, 8-14, and 27-28 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. See Office Action at pages 4-5.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

- Claims 1-6, 8-14, and 27-30², were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Phelan et al. (US 2004/0093296) ("*Phelan*") in view of the June 1999 David Haigh publication "Understanding the Financial Value of Brands" ("*Haigh*") and passages from the 2002 book written by Debashis Pati entitled "Marketing Research" ("*Pati*"). See Office Action at pages 5-8.

II. Amendments To The Claims

In response to the Office Action, Applicant amends claims 1, 9, 27, and 29. The amendments improve readability. Upon entry of the amendments and new claims, claims 1-6, 8-14, and 27-30 will be pending in this application.

Support for the claim amendments may be found, among other places, in the application as filed in the Specification at page 15, para. [0044].

III. Response to Rejections

Based on the reasoning presented below, Applicant respectfully traverses the above-identified rejections and requests the withdrawal of the rejections, reconsideration of the application, and the timely allowance of the pending claims.

A. The Rejections of Claims 1-6, 8-14, and 27-28 Under 35 U.S.C. § 101 Should Be Withdrawn.

Applicant respectfully traverses the rejection of claims 1-6, 8-14, and 27-28 under 35 U.S.C. § 101, as allegedly being directed to non-statutory matter. The Office Action points out correctly that independent claims 1 and 9 "are directed towards a method for quantifying brand development opportunities for a particular brand," but the Office Action continues that, because the claims recite "providing a system with corresponding structure," the claims "are directed to neither a 'process', 'product' nor a 'machine,' but

² In its enumeration of claims rejected under 35 USC § 103 (a), the Office Action repeated claim 8 and included claim 7, which had earlier been canceled. In this Reply to Office Action, Applicant treats the rejection under 35 USC § 103(a) as applying to claims 1-6, 8-14, and 27-30.

rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101." Office Action at 2-3.

Similarly, the Office Action asserts that independent claim 27, "directed towards a computer readable medium having computer readable code embodied therein, . . . further recit[ing] providing a system with corresponding structure[,] . . . embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101." Office Action at page 3.

Applicant respectfully submits that independent claims 1, 9, and 27 properly recite "providing a system with corresponding structure." For example, claim 1 presents a number of hardware and software components, such as "a processor, at least one memory storing data and instructions, a display device, a user interface, and distinct software modules embodied on a computer-readable medium; wherein the distinct software modules comprise a first analysis tool module, a second analysis tool module, and a regression analysis tool module." Claims 9 and 27, while different in scope, recite similar elements. The Board of Patent Appeals and Interfaces in *Ex parte Bo Li* has found this combination statutory under the teachings of *In re Lowry*, 32 F.3d 1579 (Fed. Cir., 1994). *Ex Parte Bo Li*, Appel 2008-1213 at 9 (BPAI Nov. 6, 2008). Further, this combination is in accordance with *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008) (en banc) (recognizing that methods tied to a particular machine can be patentable).

Thus, Applicant respectfully disagrees with and traverses this rejection, but makes amendments to place claims in allowable condition. Among other elements, claim 1 now recites:

providing a system comprising a processor, at least one memory storing data and instructions, a display device, a user interface, and distinct software modules embodied on a computer-readable medium; . . . and
executing the instructions to perform the computer-implemented steps on the processor.

Accordingly and in view of the totality of these precedents, Applicant respectfully requests the withdrawal of the rejection of claims 1-6, 8-14, and 27-28 under 35 U.S.C. § 101.

B. The Rejections of Claims 1-6, 8-14, And 27-30 Under 35 U.S.C. § 112, First Paragraph, Should Be Withdrawn.

Applicant respectfully traverses the rejection of claims 1-6, 8-14, and 27-30 under 35 U.S.C. § 112, first paragraph, as allegedly being indefinite for failing to comply with the written description requirement. See Office Action at 3.

The Office Action indicates that the claims contain “subject matter which was not described in the specification in such as way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” Office Action at 3-4. The Office Action notes that “claims 1, 9, 27 and 29 were amended to add specific details regarding a particular processor, elements about distinct software modules, as well as memory to store the data.” Office Action at 4.

Applicant respectfully submits that the claims as previously amended are adequately supported by a written description. For example, Figure 8 specifically illustrates a GUI (graphic user interface) for the “probability simulator module,” one of the “distinct software modules” recited in claim 1. As explained in the Specification,

Figure 8 is an illustration of a user interface from a probability simulator that may be used for such probability analysis where a certain number of scenarios are generated in order to compute an average probability that a customer will, for example, move from one tier to the next tier in a brand pyramid. In FIG. 8, the simulator is shown simulating the total incremental gross revenue for a brand, but of course other simulators could be made. The simulator 800 shows a person the number of times that the simulator selected a random estimate of the assumptions. Thus, for the displayed chart 840, 1000 trials of random assumptions were calculated 805. The x-axis of the chart 840 shows the estimated revenue or value of the brand 845. The y-axis shows the probability that the revenue estimate will occur 810 and the number of times (i.e., the frequency) that the total revenue estimate occurred during the trials 815. The user may slide the two anchors 820 to restrict the range of results. The accuracy (i.e., the certainty) 830 of the simulation may be displayed to the user.

Specification at page 12, para. [0038]. Figure 8 as filed is a screen shot of the probability simulator module's user interface, evidencing that an embodiment of the invention was in existence at the filing of the application. The foregoing disclosure demonstrates that the inventors had possession of the invention.

Additionally, Applicant notes that the Specification discloses that “the analysis tool shown in Figure 8 may be programmed to run on a general purpose Windows-based personal computer.” Specification at page 15, para. [0044]. The Specification alternatively discloses that “the tool may be created on a Unix, Mac or other computer platform, for example.” Specification at page 15, para. [0044]. The recited “processor,” “distinct software modules,” and “memory” are known components of a “[g]eneral purpose Windows-based personal computer” and a “Unix, Mac or other computer platform.”

Further, the Manual Patent Examination Procedure (MPEP) § 2163.02 specifies, “The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.” The Specification discloses that the “invention relates to marketing, and specifically to a method of combining several **computer-based** modeling techniques.” Specification at page 1, para. [0001]. Emphasis added. It is well known that computer-based techniques require processors, distinct software modules, and memory components for implementation. In addition, the Abstract identifies the “computer-based modeling techniques” that “may be used in novel combinations” as “[i]mage/Attitudinal driver analysis, pyramid analysis, probability analysis, trade-off analysis, and other regression techniques.” *Id.*

The Specification discloses examples of the modeling techniques that may be combined in detail in Figure 3 and in the Specification:

- brand imagery analysis (also referred to as image/equity analysis): steps 305-315 of Figure 3 and in the Specification at page 6, para. [0023] through page 7, para. [0025];
- brand pyramid analysis: steps 320-330 of Figure 3 and in the Specification at page 7, para. [0026] through page 9, para. [0030];
- tier by tier analysis: step 340 of Figure 3 and in the Specification at page 9, para. [0031] through page 10, para. [0033];
- trade-off analysis: steps 345 of Figure 3 and in the Specification at page 11, para. [0034];
- econometric analysis and probability analysis: step 350 of Figure 3 and in the Specification at page 11, para. [0035] through page 12, para. [0038]; and

- assess findings by synthesizing: step 355 of Figure 3 and in the Specification at page 13, para. [0039] through page 15, para. [0043].

Because the modeling techniques are described as being computer-based, one of ordinary skill would understand that the modeling techniques could be implemented as software. Further, because the functionality of the modeling techniques are disclosed in detail in the Specification in the above-cited locations, according to MPEP § 2163, the modeling software modules are adequately described in the Specification.

As a general rule, where software constitutes part of a best mode of carrying out an invention, description of such a best mode is satisfied by a disclosure of the functions of the software. This is because, normally, writing code for such software is within the skill of the art, not requiring undue experimentation, once its functions have been disclosed. * * * Thus, flow charts or source code listings are not a requirement for adequately disclosing the functions of software.

MPEP § 2163, quoting *Fonar Corp. v. General Electric Co.*, 107 F.3d 1543, 1549, 41 USPQ2d 1801, 1805 (Fed. Cir. 1997).

Applicant respectfully submits that the implications of a processor, distinct software modules, and memory as derived from the figures and the Specification is amply sufficient to satisfy the description requirement. Thus, the disclosure in the Specification and Figures 3 and 8 of the “**computer-based** modeling techniques” (and their functionalities) and the “user interface from a probability simulator” describe a “processor,” “distinct software modules,” and “memory” as claimed.

Applicant submits that the disclosure in the Specification and illustrated in Figures 3 and 8 of the computer-based modeling techniques and analysis tool necessarily discloses the functionality of the processor, distinct software modules, and memory, and that the disclosure of such functionality is “a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and [it sets] forth the best mode contemplated by the inventor of carrying out his invention,” as is required by 35 U.S.C. § 112, first paragraph.

As such, claim 1, reciting

a system comprising a processor, at least one memory storing data and instructions, a display device, a user interface, and distinct software modules

embodied on a computer-readable medium; wherein the distinct software modules comprise a first analysis tool module, a second analysis tool module, and a regression analysis tool module; and wherein the distinct software modules are configured to access the at least one memory for data and instructions and, when executing the instructions, to perform the computer-implemented steps,

and related dependent claims 2-6 and 8, meet the requirements of 35 U.S.C. § 112, first paragraph.

Claims 9 and 27, while different in scope, recite similar elements. Therefore, for the same reasons, claim 9 (and related dependent claims 10-14) and claim 27 (and related dependent claim 28) meet the requirements of 35 U.S.C. § 112, first paragraph.

In view of the above, Applicant respectfully requests the withdrawal of the rejection of claims 1-6, 8-14, and 27-30 under 35 U.S.C. § 112, first paragraph.

C. The Rejections of Claims 1-6, 8-14, and 27-28 Under 35 U.S.C. § 112, Second Paragraph, Should Be Withdrawn.

Applicant respectfully traverses the rejection of claims 1-6, 8-14, and 27-28 under 35 U.S.C. § 112, second paragraph, as allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Office Action asserts that “[a] single claim which purports to be both a product or machine and a process is ambiguous and is properly rejected under 35 USC 112, second paragraph, for failing to particularly point out and distinctly claim the invention.” Office Action at 4-5, quoting *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990).

Ex parte Lyell is discussed in MPEP 2173.05(p) in connection with the indefiniteness of claims that claim “both an apparatus and the method steps of using the apparatus.” The *Ex parte Lyell* claim that was held to be ambiguous and rejected under 35 U.S.C. 112, second paragraph, was directed to elements in two separate classes of statutory subject matter in its preamble, “transmission repair tool” and “the method of using same,” as opposed to the instant claim 1, which recites a “method” comprising, among other element, providing elements to perform the method, namely, “providing a system comprising a processor, at least one memory storing data and instructions, a display device, a user interface, and distinct software modules embodied on a computer-readable medium.”

As noted above, the Board of Patent Appeals and Interfaces in *Ex parte Bo Li* has found this combination statutory under the teachings of *In re Lowry*, 32 F.3d 1579 (Fed. Cir., 1994). *Ex Parte Bo Li*, Appel 2008-1213 at 9 (BPAI 2008). Further, this combination is consistent with the standard for patentability of a method claim set forth in *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008) (en banc).

Accordingly, claim 1, and related dependent claims 2-6 and 8, meet the requirements of 35 U.S.C. § 112, second paragraph. Claims 9 and 27, while different in scope, recite similar elements. Therefore, for the same reasons, claim 9 (and related dependent claims 10-14) and claim 27 (and related dependent claim 28) meet the requirements of 35 U.S.C. § 112, second paragraph.

In view of the above, Applicant respectfully requests the withdrawal of the rejection of claims 1-6, 8-14, and 27-28 under 35 U.S.C. § 112, second paragraph.

D. The Rejections of Claims 1-6, 8-14, and 27-28 Under 35 U.S.C. § 103(A) Should Be Withdrawn.

Applicant respectfully traverses the rejection of claims 1-6, 8-14, and 27-28 under 35 U.S.C. § 103 as allegedly being obvious over *Phelan* in view of *Haigh* and *Pati*, because a *prima facie* case of obviousness has not been established.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." MPEP § 2142, 8th Ed., Rev. 7 (July 2008) (internal citation and inner quotation omitted). "[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." MPEP § 2141(II). In rejecting a claim, "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." MPEP § 2141(III).

Claim 1 calls for a combination including, for example, "providing a system comprising . . . a regression analysis tool module" and "determining, by the regression analysis tool module, brand loyalty or brand image factors and information about the

brand loyalty or brand image factors, wherein results of the determining step are based on results of the first analysis and results of the second analysis." *Phelan* fails to teach or suggest "determining, by the regression analysis tool module, brand loyalty or brand image factors and information about the brand loyalty or brand image factors" or that "results of the determining step are based on results of the first analysis and results of the second analysis," as recited in claim 1.

The Office Action alleged that *Phelan's* use by the marketing mix model of statistical regression techniques in para. 127 of *Phelan* constitutes the claimed "determining, by the regression analysis tool module, brand loyalty or brand image factors and information about the brand loyalty or brand image factors." However, this is not correct. *Phelan* discloses:

A marketing mix model uses statistical regression techniques to determine the impact of the components of the marketing mix on a specific business measure, such as on volume, share, and/or sales. The marketing mix model uses "controllables," or factors that the modeler (e.g., the market client 104) controls, such as the amount of advertising investment over a time period, the promotions run, etc. The modeler (e.g., the market client 104) needs to access all marketing mix investments (e.g., event plans) by a predetermined time period (e.g., week) for the historical period to create the model.

Phelan at [0127]. Thus, it can be seen that the regression analysis of the marketing mix model **uses factors** as inputs to **determine** impact of the components of the marketing mix on a specific business measure, such as on volume, share, and/or sales.

The Office Action appears to analogize the *Phelan* "controllables" factors to the recited "brand loyalty or brand image factors and information about the brand loyalty or brand image factors" of claim 1. However, this is not correct. *Phelan's* "controllables" are defined to be "factors that the modeler (e.g., the market client 104) controls." *Phelan* at [0127]. Examples of "controllables" given in *Phelan* include "the amount of advertising investment over a time period [and] the promotions run." *Id.* Applicant does not concede that the recited "brand loyalty or brand image factors and information" are "factors that the modeler . . . controls," but, even if they were, the recited "brand loyalty or brand image factors and information" are different from *Phelan's* "controllables" because "controllables" are included **in** the model, while, as recited, the "brand loyalty

or brand image factors and information" are "**determin[ed]** by the regression analysis tool module."

The "controllables" disclosed by *Phelan*, "the amount of advertising investment over a time period, the promotions run, etc.," are described as inputs to the model: "The marketing mix model **uses** 'controllables.'" *Phelan* at [0127], emphasis added. The *Phelan* modeler inputs the factors **into** the marketing mix models: "The modeler (e.g., the market client 104) needs to access all marketing mix investments (e.g., event plans) by a predetermined time period (e.g., week) for the historical period to create the model. . . . The modeler compiles historical values for these factors." *Phelan* at [0127].

Phelan's "controllables" factors are not disclosed as output of the model, and so they cannot be considered analogous to the "brand loyalty or brand image factors and information about the brand loyalty or brand image factors," as recited in claim 1. The output of the *Phelan* model is described as a determined "impact of the components of the marketing mix on a specific business measure, such as on volume, share, and/or sales." *Phelan* at [0127].

Phelan does not teach or suggest that its model outputs, the determined "impact of the components of the marketing mix on a specific business measure, such as on volume, share, and/or sales" are "brand loyalty or brand image factors and information about the brand loyalty or brand image factors," which are "determin[ed] by the regression analysis tool module," as recited in claim 1. Further, *Phelan* does not teach or suggest that the determined "impact of the components of the marketing mix on a specific business measure, such as on volume, share, and/or sales" are "controllables".

It can thus be seen that the *Phelan* marketing mix model **uses** factors; it does not **determine** factors. In contrast, the method of claim 1. "determin[es], by the regression analysis tool module, brand loyalty or brand image factors and information about the brand loyalty or brand image factors."

In addition, it can be seen that *Phelan* does not suggest or teach that "results of the determining step are based on results of the first analysis and results of the second analysis," as recited in claim 1. The Office Action cites *Phelan* at [0145] to disclose "linking a first guided analysis with a second or multiple analysis." Office Action at 6. *Phelan* at [0145] discloses that "the guided analysis module 958 performs the guided

analysis by linking a first guided analysis component 974 with a second guided analysis component 976 [or] any number of guided analysis components." The Office Action appears to analogize the *Phelan* "guided analysis components" to the recited "first analysis" and "second analysis" of claim 1; and it appears to analogize the *Phelan* "linking" with the recited "results of the determining step [being] based on results of the first analysis and results of the second analysis" of claim 1. However, these analogies are not correct.

The *Phelan* linked guided analysis components are described as "one or more attributes 980 used in an analysis step." *Phelan* at [0145] Attribute examples are disclosed in *Phelan* to "include a measurement, a dimension, a filter, a drill level, a chart type, a chart setting, and a model term." *Id.* Another component example disclosed in *Phelan* is "marketing data 216." *Id.* Thus, the *Phelan* components are disclosed to be **data elements**, not the analyses as recited in claim 1.

Further, the linking disclosed in *Phelan* is described as "**carr[ying] common attributes** 980 forward from the first guided analysis component 974 to the second guided analysis component 976." *Phelan* at [0145], emphasis added. The linking is also described as "**enabl[ing] annotation of and publishing of the analysis components** [so that] the first market client 104 can create a first guided analysis component 974 and a second market client 124 can **view** the first guided analysis component 974 on the web." *Id.*, emphasis added. Thus the linking described in *Phelan* links together common attributes or allows views of components, but the *Phelan* linking does not teach or suggest "results of the determining step [being] based on results of the first analysis and results of the second analysis," as recited in claim 1.

The Office Action cited *Haigh* as a teaching of "the first analysis tool module and the second analysis tool module [being] chosen from the group comprising: an image/equity analysis tool . . . , a brand pyramid analysis tool . . . , a trade-off analysis tool . . . , a probability simulator . . . , an econometric analysis tool . . . , a behavioral analysis tool . . . , and a brand pyramid conversion analysis tool." Office Action at 6-7. In addition, the Office Action cited *Pati* as a teaching of "the output and display of image perceptual maps of brand factors." Office Action at 8. Even assuming the Examiner's characterization of *Pati* is correct, which Applicant does not concede, both *Haigh* and

Pati fail to cure the deficiencies of *Phelan*, discussed above. That is, both *Haigh* and *Pati*, also, fail to teach or suggest "determining, by the regression analysis tool module, brand loyalty or brand image factors and information about the brand loyalty or brand image factors" or that "results of the determining step are based on results of the first analysis and results of the second analysis," as recited in claim 1.

In view of the mischaracterization of the prior art set forth above, the Office Action has neither properly determined the scope and content of the prior art nor ascertained the differences between the claimed invention and the prior art. Moreover, the Office Action has provided no motivation for one of ordinary skill in the art to modify the teachings of the prior art to achieve the claimed combinations. Accordingly, no reason has been articulated as to why one of skill in the art would find the claimed combination obvious in view of the prior art. For at least this reason, no *prima facie* case of obviousness has been established. The rejection of claim 1, and dependent claims 2-6 and 8, under 35 U.S.C. §103 as being obvious from *Phelan* in view of *Haigh* and *Pati* is thus improper and should be withdrawn.

In addition, independent claims 9, 27, and 29, although different in scope from claim 1, recite elements similar to claim 1 and were rejected for similar reasons. See Office Action at 4. For at least the reasons stated above with respect to claim 1, claim 9 and related dependent claims 10-14, claim 27 and related dependent claim 28, and claim 29 and related dependent claim 30 are also allowable.

In view of the above, Applicant respectfully requests the withdrawal of the rejection of claims 1-6, 8-14, and 27-28 under 35 U.S.C. § 103(a).

IV. Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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